

## **REMARKS**

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

### **Regarding the Claim Objections**

Applicant has amended claims 18, 32 and 33 to overcome the objections noted in the Office Action of August 21, 2006. The Applicant appreciates the examiner bringing these informalities to the attention of the undersigned. It is believed that the amendments to overcome the objections are done solely to address the informalities noted and do not affect the scope of the claims. Allowance of these claims are now earnestly solicited at the examiner's earliest convenience.

### **Regarding the Double Patenting Rejection**

Applicant must respectfully but strenuously object to the assertion that claims 1-9, 14-22, and 28-38 of the instant application are unpatentable over claims 1-29 of U.S. Patent No. 6,661,409, hereinafter the '409 reference.

The examiner asserts that these claims, while not identical, are not patentably distinct from the claims of the '409 patent. The claims as filed, and particularly as amended herein, define patentably distinct subject matter. The instant claims recite displaying "one or more of recognized text and digital ink" in a display element and the instant specification makes it clear that these are two different things that may be displayed. The recognized text is generated by putting the written input, input at a touch input screen, for example, through a recognition element, while the digital ink, as used in the claim(s), "corresponds to the written input" and is not passed through a recognition element. By claim 1, for example, reciting a display element "operable to display *one or more of* recognized text and digital ink" (emphasis added), it is clear that recognized text is separate from digital ink and Applicant respectfully submits that this understanding is clear from the claim language and specification as filed. Applicant has nonetheless amended certain of the claims to better clarify this. Claim 1, for example, has been amended to clarify this relationship, as have claims 4 and 29 which have been amended to recite that displaying the digital ink in a display area separate from the input area does not require the use of a recognition element.

Applicant respectfully submits that the ‘409 patent taught the use of a recognition element or engine to convert the input entered by the user to text that would then be displayed in the display area 105. There is no teaching or suggestion in the ‘409 patent that the input could be entered and then displayed, directly or otherwise, as digital ink corresponding to the entered input; there is only teaching of processing the entered data through a recognition element to generate text that would then to displayed in the display area. The teachings and claims of the instant application make it clear that the written input may be either passed through a recognition element or engine to generate text to be displayed in the display area 105, separate from the input area 104, or that the digital ink corresponding to the entered input but not passed through a recognition element may itself be displayed in display area 105.

The instant specification discusses at length digital ink displayed in display area 105, as being separate from text generated by a recognition element that may also be displayed in display area 105. The examiner is respectfully directed to page 4, lines 1-6; page 8, lines 18-21, 26-28; page 17, lines 15-21; page 18, lines 10-14. Conversion of written input to digital ink is further discussed at page 18, line 16 to page 19, line 9; and page 19, lines 11-18. Digital ink options, shown in Figure 3, and including digital ink modification in the display area are discussed at page 11, lines 9-13; page 12, lines 6-19; and page 20, line 17 to page 21, line 5. Directly displaying the written input as digital ink is discussed at page 13, lines 1-3; page 14, lines 14-16; page 16, lines 1-3; and page 17, lines 15-21. Toggling between an ink only mode and a text recognition mode (the only mode discussed in the ‘409 patent) is explored at page 20, lines 10-17, as well as the options (and/or) being discussed at page 10, line 25 to page 11, line 6.

The ‘409 reference, conversely, teaches only display of recognized text after it has been processed by a recognition element or engine. In ‘409, digital ink refers to the written input being displayed in the input area 104, not display area 105. Please refer to column 2, lines 55-61; column 3, lines 53-56, etc. Column 3, line 22, recites “if recognition is included” but there is no teaching, other than recognition to generate recognized text, of what could be displayed in area 105.

In light of the foregoing reasons and the amendments to the independent claims to better clarify the subject matter of the invention, Applicant respectfully asserts that the Double Patenting rejection of the instant claims over the ‘409 patent should be withdrawn. Applicant

does not forfeit its right to file a terminal disclaimer, and in the event that this basis of rejection is maintained, Applicant reserves the right to file a terminal disclaimer.

**Regarding the Rejections Under 35 U.S.C. §102**

The present Office Action rejects claims 1-11, 14-22 and 24-38 as anticipated by the Demartines et al. reference of record, the ‘409 patent referenced above. Applicant respectfully traverses this ground of rejection.

Applicant respectfully directs the examiner to some of the differences between the ‘409 patent and the instant claims discussed at length above. While the ‘409 reference teaches the use of a recognition element or engine to convert written input to recognized text to be displayed at display area 105, there is no teaching of displaying digital ink, corresponding to the written input, in display area 105. Again, the examiner is respectfully directed to the many passages from the instant application disclosed above.

With respect to claim 1, applicant has amended this claim not to change the scope of the claim as filed, but to better clarify it. The claim, as filed, recites “said display element operable to display one or more of recognized text and digital ink”. This recitation, together with the teachings of the specification discussed above, make it clear that recognized text and digital ink are not the same. Recognized text is determined from the written input using a recognition feature while digital ink corresponds to the written input as input and may be edited by the user.

Moreover, the examiner references both 104, 105 for the display element. The claims, however, recite two different areas, an input area called a touch input screen (104) and a display element (105); they are capable of displaying separate data, as discussed above. Column 3, lines 53-56, of the ‘409 reference do not teach displaying digital ink in the display element. Rather, they teach displaying digital ink only in the input area 104. The examiner again references column 3, lines 22-28 as teaching the digital ink, but this passage refers to recognition being used. There is no teaching of the digital ink corresponding to the written input. Column 3, lines 29-39 does not discuss editing at all; this refers to continuous writing.

With regard to claim 3, the examiner asserts that 105 in Figure 1 of the ‘409 reference teaches displaying one or more of corresponding digital ink and recognized text. Again, the ‘409 reference only teaches displaying recognized text in display 105. Please see above discussion.

With regard to independent claim 4, the claim as filed states that the handwritten input is displayed in the display area as digital ink and this is different from the ‘409 reference. Nonetheless, the claim has been amended to state that the digital ink corresponds to the handwritten input and is displayed without the requirement of being converted to text using a recognition element.

With regard to claim 10, this claim depends from claim 4; moreover, the claim recites menu options with regard to the “digital ink” – again, as defined in claim 4, this is different from the recognized text taught in the ‘409 reference. Furthermore, displaying a menu of possible functions to the user in the handwritten input area is not anticipated by 128 in Figure 2 of the ‘409 reference, contrary to the examiner’s assertion. Column 4, lines 65-66, recite “pop-up list 128 of recognition choices.” (emphasis added) and, it is clear from Figure 2 that pop-up list 128 is in the display area 105, not the input area 104. Similar arguments are made with respect to claim 11, which depends from claim 10.

With regard to independent claim 18, this claim as filed clearly has two display areas of the HIUI: the automatically scrollable output area and the text output area “operable to display the digital ink strokes corresponding to stylus entries made...” Nonetheless, this claim has been amended to make it clear that the words displayed in this area do not require the use of recognition technology.

With regard to claim 19, the recitations of dependent claim 20 have been placed into this claim; no new issues or subject matter has been added by amendment, the recitations in claim 20 as filed.

With regard to claims 23-27, these claims all make reference to design ink modification in the display area, never taught or suggested by the ‘409 reference. As discussed above, design ink modification in the display area 105 is discussed in the instant specification as filed, including at page 20, line 17 to page 21, line 5.

With regard to independent claim 29, this claim as filed recites “computer readable program code means for *converting said written entry into digital ink*,” (emphasis added) Moreover, Applicant has added to this claim that the digital ink is displayed without the requirement of a recognition element converting written input to text. As discussed above, this recitation is clearly not taught, disclosed or suggested by the ‘409 reference.

With regard to independent claim 32, this claim has been clarified to distinguish the claim over the '409 reference by stating that the digital ink may be displayed directly without benefit of a recognition function. It is noted that this recitation is further developed in claim 36 as originally filed and thus does not represent new matter or issues for the Office.

**Regarding the Rejections Under 35 U.S.C. §103**

Claims 12, 13, and 23 are rejected over the '409 reference. Applicant respectfully traverses, and notes that these claims depend from claims 4 and 19, respectively. For the reasons set forth extensively above with respect to the clear differences between the independent instant claims and the '409 reference, Applicant respectfully asserts that this basis of rejection is overcome.

**Concluding Remarks**

The undersigned additionally notes that other distinctions may exist between the cited art and the claims, and reiterates the distinctions previously discussed in the prior response. In view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to explicitly address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort.

In view of this communication, all claims are believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Respectfully submitted,

/Michelle Leveque/

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